

REMARKS

Claim Amendment:

Applicant notes that claim 29 has been amended to clarify the claimed invention and to ensure that the scope of the claim is clear. Applicant notes that the above referenced claim amendment has been made to merely clarify the claimed invention and is not intended to narrow the original scope or spirit of the claim, in any way.

Claim Rejections:

Claims 1-24, 26-37 and 39-44 are all of the claims pending in the present application, and currently all of these claims stand rejected.

35 U.S.C. § 102(e) Rejection - Claims 1-2, 4, 6-7, 9-16, 18, 20-21, 23-24, 26-30, 32, 34-37, 39-40, and 43-44:

Claims 1-2, 4, 6-7, 9-16, 18, 20-21, 23-24, 26-30, 32, 34-37, 39-40, and 43-44 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,085,009 to Risch et al. In view of the following discussion, Applicant respectfully traverses the Examiner's rejection of these claims.

As an initial matter, it is noted that the Examiner is continuing to maintain that the buffer tubes **12** of Risch teach the "gel-swellable portion" of the present invention. In making this argument, the Examiner is making a number of assertions, which Applicant respectfully takes issue with.

First, the Examiner states that the buffer tube **12** in Risch is disclosed as being made from an i-PP (i.e. impact modified polypropylene) material, and that "i-PP tubes *typically* have a

density less than 0.90 g/cc as shown by U.S. Patent No. 5,911,023, column 9, table 2 (relative density of i-PP.) and therefore Risch et al ('009) *inherently* discloses a gel-swellaable buffer tube with density less than 0.90 g/cc.” See Office Action, page 3, 2nd para. (emphasis added).

Applicant submits that within this statement, the Examiner has made a contradictory statement which supports Applicant’s position. Specifically, the Examiner asserts that the buffer tube in Risch ('009) “inherently” has a density less than 0.90 g/cc, but also that this density is only “typical” of i-PP materials. Thus, even assuming that the Examiner’s assertion regarding the “typical” density is true, the Examiner has failed to establish that this claim feature is inherent in Risch.

When attempting to establish the invalidity of a claim under 35 U.S.C. § 102, it must be shown that “all of the elements and limitations of the claim are found within a single prior art reference.” Scripps Clinic & Research Foundation, Revlon, Inc. v. Genentech, Inc., 927 F.2d 1565, 1576 (Fed. Cir. 1991) (citations omitted). “There must be no difference between the claimed invention and the reference disclosure,” the subject matter in the reference “must be identical in all material respects.” See Id.; and Hupp v. Siroflex of America Inc., 43 U.S.P.Q.2d 1887, 1890 (Fed. Cir. 1997). As stated above, this is not the case with regard to the pending claims as Risch fails to disclose the various densities of claim 1.

As referenced above, the Examiner asserts that this feature is “inherent” because of the disclosure in the Risch '023 Patent. Applicant does acknowledge that when a reference fails to expressly disclose each and every element of a claimed invention, as in this case, it can be argued that a reference “inherently” teaches the missing element or elements of the claimed invention. See In re Oelrich, 666 F.2d 578, 581 (Fed. Cir. 1981). However, evidence of

inherency in a reference “must make it clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” Continental Can Co. USA Inc. v. Monsanto Co., 948 F.2d 1264, 1269 (Fed. Cir. 1991) (emphasis added). “Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” Id. (citing In re Oelrich, 666 F.2d 578, 581 (fed. Cir. 1981) (quoting Hansgird v. Kemmer, 102 F.2d 212, 214 (C.C.P.A. 1939))) (emphasis in original); see also Scaltech Inc. v. Retec/Tetra L.L.C., 51 U.S.P.Q.2d 1055, 1059 (Fed. Cir. 1999); and In re Robertson, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Even if the prior art reference could have equally been used or made with only two possibilities, a patent claim which claims one of the two possibilities will not be anticipated because that limitation was not “necessarily” present in the prior art disclosure. See Finnigan Corp. v. I.T.C., 51 U.S.P.Q.2d 1001, 1009-10 (Fed. Cir. 1999) (holding that a prior art reference that disclosed a set-up for performing only resonance or nonresonance ejection was insufficient to show, clearly and convincingly, that nonresonance ejection was inherently taught by the prior art reference). Thus, even if it were assumed in this case that the density of i-PP was “typically” less than 0.90 g/cc, this is insufficient to establish that the density of less than 0.90 g/cc was “necessarily present” in the buffer tube **12**, disclosed in Risch. For at least this reason, Applicant submits that the Examiner’s rejection of the pending claims should be withdrawn.

In support of the above discussion, Applicant also notes that it is well known that buffer tubes can be made of different materials or different compositions. The assertion made by the Examiner above assumes that the buffer tube **12**, in Risch, is made of i-PP material only, as there

is no indication otherwise. Applicant submits that it is known that many, if not most, buffer tubes are made of compositions of materials having many various components, which can affect the density of the material. For example, Applicant notes that in many cases a nucleating agent is introduced into the buffer tube composition (which may or may not have an i-PP material) to aid in the crystallization of the composition, and such an addition would increase the density of the buffer tube.

Additionally, it is noted that the Examiner's reliance on the Risch '023 reference is misplaced, and that this reference has little or no relevance to the present invention. In using the Risch '023 reference, the Examiner relies on the "relative density" of an i-PP material used for filler rods, found in Table 2. First, it is noted that the information in Table 2 is directed to "Foamed Polyolefin Rods" and has nothing to do with buffer tubes. Second, it is noted that the Examiner's reliance on the "Relative Density" disclosed in this Table is inappropriate and has no bearing on the present invention. Specifically, it is noted that the '023 patent is directed to making rods with a material that has been foamed (i.e. having air pockets/bubbles intentionally added to the composition), and that the "Relative Density" discussed in Risch '023 is not a density at all. In fact, the "Relative Density" in Risch '023 is merely a ratio of the "Final Density"¹ over the "Starting Density"². This is evidenced by the fact that the "Relative Density" is a dimensionless value (i.e. $0.804 \text{ g/cc} / 0.905 \text{ g/cc} = 0.888$), as shown in Table 2. Thus, the reliance on this Table, by the Examiner is inappropriate because: (1) the data is drawn to filler

¹ "Final Density" is the density after foaming.

² "Starting Density" is the density prior to foaming.

rods, which have different characteristics and design requirements as compared to buffer tubes, and (2) the “relative density” has no relevance to the present invention.

Moreover, in using the data in Table 2, it is shown that the density of a non-foamed i-PP material can be 0.905 g/cc, which is directly contradictory to the Examiner’s assertion that the i-PP material used for the buffer tube **12**, in Risch, “inherently” has a density less than 0.90 g/cc.

Second, in rejecting the above claims, the Examiner states that “[a] prior art stranded optical fiber outer jacket is made of HDPE or MDPE as exemplified in U.S. Patent No. 5,911,023 (column 10 lines 32-33) and a *typical* density of HDPE is at least 0.90 g/cc, as shown in U.S. Patent No. 5,911,023 (column 9 table 2, relative density of HDPE). Therefore Risch et al (‘009) *inherently* discloses an optical fiber outer jacket with a density of at least 0.90 g/cc.” *See id.* (emphasis added). Again, Applicant disagrees with this statement for a number of reasons.

As discussed above, even if the Examiner was correct in saying that a “typical” outer jacket is made of HDPE or MDPE, this is insufficient to establish this feature as “inherent” within the disclosure of Risch (‘009). This is particularly true because Risch ‘009 does not identify any specific material, and Applicant notes that many other materials, other than HDPE or MDPE can be used for outer jackets. For example, it is known that linear low density polyethylene, or low density polyethylene can be used, and that these (or HDPE/MDPE) can be used with fillers or can be foamed. Thus, Applicant submits that any assertion regarding the “inherency” of outer jacket density is misplaced and without merit. Stated differently, for the Examiner’s assertion to be true, all outer jackets used must necessarily have a density of at least 0.90 g/cc, and this is simply not the case.

Therefore, Applicant submits that Risch '009 fails to disclose each and every feature of claim 1, either expressly or inherently.

With regard to claim 15, it is noted that this claim recites "a gel -swellable portion contacting an outer surface of [the] optical fiber." *See* claim 15. Applicant notes that there is no disclosure or suggestion, in Risch '009, of having the fibers come in contact with the buffer tubes 12. In fact, Applicant submits that it is known that it is desirable to avoid contact between buffer tubes and optical fibers. Therefore, Applicant submits that Risch '009 fails to disclose each and every feature of claim 15, either expressly or inherently.

With regard to claim 29, Applicant notes that for similar reasons as those set forth with regard to claim 1, Risch '009 fails to disclose, expressly or inherently, having a "gel-swellable portion [] made from a material softer than [] one of [the] inner surface and [the] outer surface to which [the] gel-swellable portion is proximate to." *See* claim 29. As set forth in the discussion above, the Examiner's assertions regarding the "inherency" of material densities is in error, and as such, there is no disclosure which indicates that the above referenced claim limitation is "necessarily present" in the Risch '009 reference.

In view of the foregoing, Applicant submits that Risch '009 fails to disclose, teach or suggest each and every feature of the present invention, either expressly or inherently, as set forth in claims 1, 15 and 29. Therefore, Applicant hereby requests the Examiner reconsider and withdraw the above 35 U.S.C. § 102(e) rejection of these claims. Further, as claims 2, 4, 6-7, 9-14, 16, 18, 20-21, 23-24, 26-28, 30, 32, 34-37, 39-40, and 43-44 depend on these claims, respectively, Applicant submits that these claims are also allowable, at least by reason of their dependence.

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Application No.: 09/851,247

Our Ref.: A7966
Art Unit: 2874

35 U.S.C. § 103(a) Rejection - Claims 3, 5, 8, 17, 19, 22, 31, 33, 41 and 42:

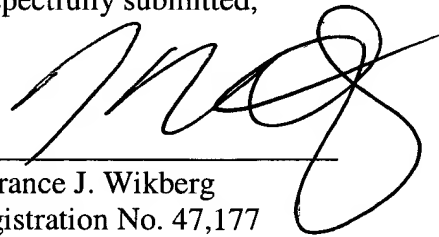
Claims 3, 5, 8, 17, 19, 22, 31, 33, 41 and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Risch '009 Patent. However, as these claims depend on claims 1, 15, and 29, respectively, Applicant submits that these claims are also allowable, at least by reason of their dependence.

Conclusion:

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Terrance J. Wikberg
Registration No. 47,177

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: September 23, 2003